IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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TITLE: METHOD, SYSTEM, AND GRAPHIC USER INTERFACE FOR
AUTOMATED ASSET MANAGEMENT

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MAIL STOP APPEAL BRIEF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

RESUBMISSION OF APPELLANTS' BRIEF

This is a resubmission of the Appeal Brief that was originally filed on March 31, 2008, which was filed in furtherance of the Notice of Appeal filed in this case on January 31, 2008.

The fee for filing of this Appeal Brief has already been charged to Deposit Account No. 09-0461.

This resubmission is being filed in response to the Notice of Non-Compliant Appeal Brief, mailed April 17, 2008, having a period for response set to expire on May 17, 2008. Applicant petitions for a two-month extension of time to reply to this Notice, to July 17, 2008. **The Commissioner is authorized to charge the fee for a two-month extension of time to file this resubmission to Deposit Account No. 50-4364.**

Applicant notes that the Appeal Brief filed on March 31, 2008 contained an incorrect listing of the pending claims in the Claims Appendix. This Resubmission sets forth the correct set of currently pending claims in the Claims Appendix. Applicant submits respectfully that the subject matter claimed in all independent claims (claims 1, 11, and 21) are properly mapped to page and line numbers in the specification.

1.   REAL PARTY IN INTEREST

The present application is assigned to International Business Machines Corporation, having its principal place of business at New Orchard Road, Armonk, New York 10504. Accordingly, International Business Machines Corporation is the real party in interest.

2.   RELATED APPEALS AND INTERFERENCES

The Appellants, assignee, and the legal representatives of both are unaware of any other appeal or interference which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

3.   STATUS OF CLAIMS

A.   Claims canceled: none

B.   Claims withdrawn from consideration but not canceled: None

C.   Claims pending: 1-30

D.   Claims allowed: none

E. Claims rejected: 1-30

F. Claims appealed: 1-30

Appealed claims 1-30 as currently pending are attached as the Claims Appendix hereto.

4. STATUS OF AMENDMENTS

There are no un-entered amendments to the specification claims or drawings in this case.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

Claim 1: A method of managing assets controlled by members of an organization, said organization having a central server configured to access data and software systems of said organization, comprising the steps of:

identifying one or more of said assets for management and submitting an asset disposition request to said central server (page 7, lines 19-20; page 8, lines 17-18; Fig. 2);

at the central server, automatically, based on receipt of said asset disposition request, obtaining all required approvals for said asset disposition request (page 9, line 14 to page 10, line 6);

at the central server, automatically, based on said obtaining of all required approvals, effecting said asset disposition request (page 13, line 21 to page 14, line 1); and

at the central server, automatically modifying said data to reflect said effected disposition request (page 14, lines 1-4).

Claim 11: A system for managing assets controlled by members of an organization, said organization having a central server configured to access data and software systems of said organization, comprising:

means for identifying one or more of said assets for management and submitting an asset disposition request to said central server (page 7, lines 19-20; page 8, lines 17-18; Fig. 2);

means for automatically, at the central server, based on receipt of said asset disposition request, obtaining all required approvals for said asset disposition request (page 9, line 14 to page 10, line 6);

means for automatically, at the central server, based on said obtaining of all required approvals, effecting said asset disposition request (page 13, line 21 to page 14, line 1); and

means for automatically, at the central server, modifying said data to reflect said effected disposition request (page 14, lines 1-4).

In accordance with 37 CFR 41.37(c)(1)(vii), the structure, materials, or acts corresponding to each the means plus function clause recited in claim 11 is identified and described in the portions of the specification which are cited immediately following each clause of claim 11, above.

Claim 21: A computer program product for managing assets controlled by members of an organization, said organization having a central server configured to access data and software systems of said organization, the computer program product comprising a computer-readable storage medium having computer-readable program code embodied in the medium, the

computer-readable program code comprising:

computer-readable program code that identifies one or more of said assets for

management and submits an asset disposition request to said central server (page 7, lines 19-20;

page 8, lines 17-18; Fig. 2);

computer-readable program code that automatically, based on receipt of said asset

disposition request, obtains all required approvals for said asset disposition request (page 9, line

14 to page 10, line 6);

computer-readable program code that automatically, based on said obtaining of all

required approvals, effects said asset disposition request (page 13, line 21 to page 14, line 1); and

computer-readable program code that automatically modifies said data to reflect said effected

disposition request (page 14, lines 1-4).

The present invention teaches a business asset management system, method, and

computer-program product that operates in real time to allow all aspects of asset management to

be performed automatically at a central server. The claimed asset management process is

initiated by an employee of an organization using a client platform and then submitted to a

central server. Once the asset management process request is received by the central server from

the client platform, the single, central server automatically performs all the steps of the process.

When the process is complete, the central server immediately automatically updates the

organization's data in real time to reflect that the asset management process has been completed.

6.   **GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Appellants request the Board to review the following rejections:

A.   Rejection of claims 1-30 under 35 U.S.C. §102(b) as being anticipated by Chapter

7 (Disposition Sections 7.1,

http://www.standford.edu/dept/UPA/chapter%207.html) (referred to herein as

"Chapter 7").

7.   **ARGUMENT**

A.   **Rejection of claims 1-30 under 35 U.S.C. §102(b) as being anticipated by Chapter 7**

The Examiner Has Not Established a *Prima Facie* Case of Anticipation

As set forth in the MPEP:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.@ MPEP ʼ2131 citing *Verdegaal Bros. v. Union Oil Company of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987)

The Examiner Has Not Established a *prima facie* Case of Anticipation

As noted above, the present claimed invention includes a central server that automatically performs the steps required to manage an organization's disposal of assets. The central server automatically obtains all required approvals for said asset disposition request, automatically effects said asset disposition request, and automatically modifies said data to reflect said effected disposition request. As a result, employees of the organization are not required to spend time researching information about an asset in order to know what the proper procedure is for disposing of

that asset. Additionally, the organization's asset management data is updated in real time to reflect changes in the status of its assets.

In contrast to the present claimed invention, Chapter 7 does not control its asset management through a central server. Rather, Chapter 7 gives directions to the several different employees of several different departments in an organization regarding the manual steps that must be taken in order to dispose of the organization's assets. The document informs the individual employees what specific, manual steps they are to carry out in the procedure. In the procedures listed in Chapter 7, an employee is directed to dispose of an asset by submitting an on-line disposal request (DR). Once an employee submits the on-line DR, Chapter 7 lists the information that various employees and departments in the organization must gather about the asset and lists the steps that employees must perform in order to complete the asset disposal procedure. All the steps listed in Chapter 7 are carried out manually by multiple employees of multiple departments in the organization. Specifically, the table beginning on page 11, line 19 lists nine steps of the procedure that must be manually performed by designated employees/departments of the organization. For example, in step 3 on page 11, lines 25-27, a person in the Property Management Office (PMO) reviews and approves a DR and then routes the DR to a person in the Surplus Property Sales division. In step 8 on page 12, lines 20-22, a person in the PMO updates the organization's records to reflect the disposal of the asset.

In the Response to Arguments section on page 7-8 of the final Office Action, the Examiner asserts that simply because the Chapter 7 document includes the word 'online', the procedure disclosed in the document is fully automated at a central server. The Examiner states that a central

server is nothing but a computer dedicated to a certain purpose. However, in the same paragraph, the Examiner states that Chapter 7 comprises multiple computers, servers, databases, circuits/dedicated lines and routers – all the equipment needed for online transactions. The Examiner's position appears to contradict itself because, clearly, multiple computers and servers are not the same a single central server that performs all the steps of the present invention.

The Examiner states that page 5, line 16 of Chapter 7 discloses a central server configured to access data and software systems of said organization. However, nowhere does Chapter 7 contain any type of disclosure about any type of server. Page 5, line 16 on Chapter 7 simply discloses that disposal requests can be submitted online. The Examiner appears to be basing his entire argument on the word 'online' that appears on page 5, line 16 in the Chapter 7 document, contending that this single word implies not only that the entire procedure of Chapter 7 is fully automated but that it is performed by a central server. This is incorrect. The word 'online' does not disclose or suggest the automatic performance of the steps at a central server, as in the present invention. Chapter 7 clearly states, in the table on pages 11-12 of for example, that the various steps listed in the document are performed by several different people in several different departments in an organization. The word 'online' merely implies that a computer network is involved in some facet of the Chapter 7 procedure, nothing more. Nothing in Chapter 7 teaches or suggests that a central server automatically obtains all required approvals for said asset disposition request, automatically effects said asset disposition request, and automatically modifies said data to reflect said effected disposition request as in the claimed invention.

Similarly, the Examiner states that page 5, line 27 of Chapter 7 discloses identifying one or more of said assets for management and submitting an asset disposition request to said central server. However, the five word sentence pointed to by the Examiner ("identify items which are excess") makes no mention of any type of server and the identification referred to in that line is only a classification of whether an asset is "excess" or not. Nothing in the cited passage or anywhere else in Chapter 7 discloses that an asset disposition request is submitted to a central server that automatically performs the disposition and updates the organization's data, as recited in the independent claims of the present invention.

The Examiner further states that page 12, step 8 of Chapter 7 discloses automatically modifying said data to reflect said effected disposition request at the central server. However, the cited passage specifically discloses that it is the responsibility of a person in the Property Management Office (PMO) to manually update the records with the sales/scrap data per Surplus Property Sales (SPS) disposition report. A person in one division of the organization (PMO) must manually update the organization's data based on information contained in a monthly report generated by another division of the organization (SPS). This type of manual updating of the organization's records by different departments disclosed in Chapter 7 (and the delays and potential errors associated with it) is precisely the problem in the prior art that the present invention solves.

In a telephone interview with the Examiner on December 13, 2007, the Examiner further stated that In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) supported the position that the present claimed invention, in which the steps are performed automatically at a central server, is not patentable. However, In re Venner holds only that it is not invention to merely provide

mechanical or automatic means to replace manual activity which accomplished the same result. The present invention does not merely replace manual activity with mechanical activity which accomplishes the same result. Rather, the present invention also provides a different structure that automatically performs, at a central server, all the steps of obtaining automated approval for an asset management process, consolidating the process to a single entity and dramatically decreasing both the time, expense and effort required for asset disposal.

Unlike Chapter 7, the present system allows users to obtain automated approval for an asset management process when they initiate the process. The steps of the process are carried out at a central server. The system also ensures that assets are written off the books as soon as they have been disposed of. Further, a listing of surplus assets that can be utilized by other employees in the company is created and made available to the employees, and employees are able to transfer assets to other employees, and update assets as appropriate. The process of Chapter 7 provides none of these benefits.

In summary, although Chapter 7 discloses using computers for on-line form submission and email to send messages from one employee to another in order to perform isolated steps of the asset disposal process outlined in the document, nowhere does Chapter 7 disclose a central server or any type of computer that will automatically carry out the process of asset management and the updating of organization records as in the claimed invention. Accordingly, each of the independent claims (Claims 1, 11 and 21), and all claims depending therefrom, patentably define over Chapter 7 and are in condition for allowance.

8.   CONCLUSION

For the foregoing reasons applicants respectfully request this Board to overrule the

Examiner's rejections and allow Claims 1-30.

Respectfully submitted,

June 23, 2008
Date

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CLAIMS APPENDIX

CLAIMS INVOLVED IN THIS APPEAL:

1. (Previously presented) A method of managing assets controlled by members of an organization, said organization having a central server configured to access data and software systems of said organization, comprising the steps of:

identifying one or more of said assets for management and submitting an asset disposition request to said central server;

at the central server, automatically, based on receipt of said asset disposition request, obtaining all required approvals for said asset disposition request;

at the central server, automatically, based on said obtaining of all required approvals, effecting said asset disposition request; and

at the central server, automatically modifying said data to reflect said effected disposition request.

2. (Original) A method as set forth in claim 1, wherein said step of automatically modifying said data comprises modifying financial data of said organization.

3. (Original) A method as set forth in claim 2, wherein said financial data comprises at least tax records and balance sheets.

4. (Original) A method as set forth in claim 1, wherein said data includes asset inventory data, personnel data, and financial data, and wherein said software systems of said organization include an automated routing system coupled to said asset inventory data, said personnel data, and said financial data, said step of automatically obtaining all required approvals comprising at least the steps of:

identifying from said asset inventory data all assets affected by said asset disposition request;

determining from if said identified assets meet a predetermined disposition criteria;

if said predetermined disposition criteria has been met, identifying from said personnel data any personnel required to approve said asset disposition request;

requesting approvals from said identified personnel using said automated routing system; and

receiving said approvals from said identified personnel using said automated routing system.

5. (Original) A method as set forth in claim 4, wherein said step of automatically effecting said asset disposition request comprises at least the steps of:

changing the control status of identified assets in accordance with said asset disposition request;

notifying, using said automated routing system, any member of said organization responsible for effecting said disposition request;

receiving, from said member(s) of said organization responsible for effecting said disposition request, confirmation that said asset disposition request has been effected; and

notifying, using said automated routing system, all members of said organization affected by said disposition.

6. (Original) A method as set forth in claim 5, wherein said disposition comprises transferring said identified asset(s) from one member to another member of said organization.

7. (Original) A method as set forth in claim 5, wherein said disposition comprises selling said identified asset(s) to a third party outside of said organization. (Original)

8. (Original) A method as set forth in claim 5, wherein said disposition comprises transferring said identified asset(s) from one department to another department within said organization.

9. (Original) A method as set forth in claim 5, wherein said disposition comprises retiring said identified asset(s).

10. (Original) A method as set forth in claim 5, wherein said disposition comprises placing said identified asset(s) in a list of surplus assets for a predetermined period of time.

11. (Previously presented) A system for managing assets controlled by members of an organization, said organization having a central server configured to access data and software systems of said organization, comprising:

means for identifying one or more of said assets for management and submitting an asset disposition request to said central server;

means for automatically, at the central server, based on receipt of said asset disposition request, obtaining all required approvals for said asset disposition request;

means for automatically, at the central server, based on said obtaining of all required approvals, effecting said asset disposition request; and

means for automatically, at the central server, modifying said data to reflect said effected disposition request.

12. (Original) A system as set forth in claim 11, wherein said means for automatically modifying said data modifies financial data of said organization.

13. (Original) A system as set forth in claim 12, wherein said financial data comprises at least tax records and balance sheets.

14. (Original) A system as set forth in claim 11, wherein said data includes asset inventory data, personnel data, and financial data, and wherein said software systems of said organization include an automated routing system coupled to said asset inventory data, said

personnel data, and said financial data, said means for automatically obtaining all required approvals comprising at least:

means for identifying from said asset inventory data all assets affected by said asset disposition request;

means for determining if said identified asset(s) meet a predetermined disposition criteria;

means for identifying from said personnel data, if said predetermined disposition criteria has been met, any personnel required to approve said asset disposition request;

means for requesting approvals from said identified personnel using said automated routing system; and

means for receiving said approvals from said identified personnel using said automated routing system.

15. (Original) A system as set forth in claim 14, wherein said means for automatically effecting said asset disposition request comprises at least:

means for changing the control status of identified assets in accordance with said asset disposition request;

means for notifying any member of said organization responsible for effecting said disposition request;

means for receiving, from said member(s) of said organization responsible for effecting said disposition request, confirmation that said asset disposition request has been effected; and

means for notifying all members of said organization affected by said disposition.

16. (Original) A system as set forth in claim 15, wherein said disposition comprises transferring said identified asset(s) from one member to another member of said organization.

17. (Original) A system as set forth in claim 15, wherein said disposition comprises selling said identified asset(s) to a third party outside of said organization.

18. (Original) A system as set forth in claim 15, wherein said disposition comprises transferring said identified asset(s) from one department to another department within said organization.

19. (Original) A system as set forth in claim 15, wherein said disposition comprises retiring said identified asset(s).

20. (Original) A system as set forth in claim 15, wherein said disposition comprises placing said identified asset(s) in a list of surplus assets for a predetermined period of time.

21. (Original) A computer program product for managing assets controlled by members of an organization, said organization having a central server configured to access data and software systems of said organization, the computer program product comprising a computer-readable storage medium having computer-readable program code embodied in the medium, the

computer-readable program code comprising:

computer-readable program code that identifies one or more of said assets for

management and submits an asset disposition request to said central server;

computer-readable program code that automatically, based on receipt of said asset

disposition request, obtains all required approvals for said asset disposition request;

computer-readable program code that automatically, based on said obtaining of all

required approvals, effects said asset disposition request; and

computer-readable program code that automatically modifies said data to reflect said

effected disposition request.

22. (Original) A computer program product as set forth in claim 21, wherein the

computer-readable program code that automatically modifies said data comprises computer-

readable program code that modifies financial data of said organization.

23. (Original) A computer program product as set forth in claim 22, wherein said

financial data comprises at least tax records and balance sheets.

24. (Original) A computer program product as set forth in claim 21, wherein said data

includes asset inventory data, personnel data, and financial data, and wherein said software

systems of said organization include an automated routing system coupled to said asset inventory

data, said personnel data, and said financial data, and wherein the computer-readable program

code that automatically obtains all required approvals comprises at least:

computer-readable program code that identifies from said asset inventory data all assets affected by said asset disposition request;

computer-readable program code that determines if said identified assets meet a predetermined disposition criteria;

computer-readable program code that, if said predetermined disposition criteria has been met, identifies from said personnel data any personnel required to approve said asset disposition request;

computer-readable program code that requests approvals from said identified personnel using said automated routing system; and

computer-readable program code that receives said approvals from said identified personnel using said automated routing system.

25. (Original) A computer program product as set forth in claim 24, wherein the computer-readable program code that automatically effects said asset disposition request comprises at least:

computer-readable program code that changes the control status of identified assets in accordance with said asset disposition request;

computer-readable program code that notifies, using said automated routing system, any member of said organization responsible for effecting said disposition request;

computer-readable program code that receives, from said member(s) of said organization

responsible for effecting said disposition request, confirmation that said asset disposition request has been effected; and

computer-readable program code that notifies, using said automated routing system, all members of said organization affected by said disposition.

26. (Original) A computer program product as set forth in claim 25, wherein said disposition comprises transferring said identified asset(s) from one member to another member of said organization.

27. (Original) A computer program product as set forth in claim 25, wherein said disposition comprises selling said identified asset(s) to a third party outside of said organization.

28. (Original) A computer program product as set forth in claim 25, wherein said disposition comprises transferring said identified asset(s) from one department to another department within said organization.

29. (Original) A computer program product as set forth in claim 25, wherein said disposition comprises retiring said identified asset(s).

30. (Original) A computer program product as set forth in claim 25, wherein said disposition comprises placing said identified asset(s) in a list of surplus assets for a predetermined period of time.

EVIDENCE APPENDIX

No additional evidence is presented.

RELATED PROCEEDINGS APPENDIX

No related proceedings are presented.